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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,677	02/27/2004	Michael D. Smith	418268004US	3591

45979 7590 05/28/2009

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EXAMINER	
EVANS, KIMBERLY L	
ART UNIT	PAPER NUMBER
3629	

MAIL DATE	DELIVERY MODE
05/28/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/788,677	SMITH ET AL.	
	Examiner	Art Unit	
	KIMBERLY EVANS	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendments

1. This action is in reply to the application filed on March 9, 2009.
2. Claims 1 and 12 have been amended.
3. Claims 1-27 are currently pending and have been examined.
4. The Examiner has carefully reviewed the Applicant's response and has determined that the rejection stands and is resubmitted below addressing the claims as modified by said amendments.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

   A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

   i. Determining the scope and contents of the prior art.

ii. Ascertaining the differences between the prior art and the claims at issue.

iii. Resolving the level of ordinary skill in the pertinent art.

iv. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-27 are rejected as being unpatentable over Sundsted US Patent No 5,999,967 in view of Walker et al., US Patent No 6,146,272.

8. With respect to Claims 1, 11, 12, and 22,

Sundsted discloses the following limitations,

- *acquiring a ticket from a ticketing entity, the ticket having a value specified by a sender of a message; adding the acquired ticket to the message; and forwarding the message with the added ticket to a recipient,* (see at least Abstract: "…The method and apparatus allows the receiver of electronic mail to make a decision to accept, reject, prioritize, or expedite delivery of a piece of electronic mail based on the value of an attached electronic stamp. The apparatus consists of two complimentary parts: a sender side part with responsibility for attaching the electronic stamp; and a receiver side part with responsibility for removing the electronic stamp and filtering the electronic mail based on the value of the electronic stamp…"; Figure 2, column 4, lines 63-65: "…A Mail Transport Agent 12 connects User Agent 11 to a Network 13. Mail Transport Agent 12 knows how to route electronic mail so that it reaches its intended receiver.…")
- *ticketing entity charges sender for value of ticket* (see at least Figure 4, column 3, lines 25-32: "…First, an electronic stamp, the value of which both the sender and the receiver agree upon. Second, a sender side method and apparatus for attaching an electronic stamp to a piece of electronic mail. Third, a receiver side method and apparatus for removing an electronic stamp from a piece of electronic mail and filtering the piece of electronic mail based on the value of the electronic stamp…")

Sundsted discloses all of the above limitations, Sundsted does not distinctly describe the following limitations, but Walker as shown discloses,

- *a processor and memory* (see at least column 5 lines 45 and 46:"… The lottery terminal 300 preferably includes a processor 310 and related memory, such as a data storage device 320…")
- *wherein upon receiving the message, the recipient can conditionally, redeem the value of the ticket from the ticketing entity* (see at least Figures 4 and 10, Abstract: "…A conditional lottery ticket system is disclosed to process conditional lottery ticket transactions, including the acceptance and validation of play entries. The conditional lottery ticket system preferably includes a central lottery server and one or more remote lottery terminals.…")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method and system for filtering of electronic mail and the conditional lottery system of Walker because it is an efficient means for processing conditional lottery ticket transactions.

9. With respect to Claims 2 and 13,

Sundsted discloses all of the above limitations, Sundsted further discloses,

- *the acquired ticket includes a sender authenticating code so that a mail server that receives the message can authenticate the sender of the message*. (see at least column 7, lines 58-67: "…In step (d) Analysis Module 23 reads the identity of the sending system from Identification field 46 and the digital signature from Signature Field 47. It verifies the identity of the sending system and the integrity of the electronic stamp by testing the digital signature. If the digital signature fails the test, this is a sure indication that either the electronic stamp has been corrupted or tampered with, or someone other than the sender created the electronic stamp. In either case, the electronic stamp and the associated electronic mail should be rejected…")

10. With respect to Claim 3,

Sundsted discloses all of the above limitations, Sundsted further discloses,

- *a block of tickets is acquired at a time from the ticketing entity* (see at least Figure 3, column 6, lines 28-36: "…A Preferences Record 24 connected to Analysis Module 23. Preferences Record 24 holds user preferences. In particular, it holds the amount of compensation the sender desires for each piece of electronic mail received. Analysis Module 23 uses this information when deciding how to handle electronic mail. A History Log 25 connected to Analysis Module 23. History Log 25 holds previously received electronic stamps for record-keeping as well as billing purposes…")

11. With respect to Claims 4, 14, and 15,

Sundsted discloses all of the above limitations, Sundsted further discloses,

- *each ticket of the block includes a code from a sequence of codes generated from a start code using a one-way function*. (see at least column 3, lines 53-58: "…Third, the invention reduces the significance of the role content based filtering plays so as to make it more effective. For example, the receiver might create a list of names and addresses from which electronic mail is always accepted, even without an electronic stamp, and a list of names and addresses from which electronic mail is always rejected. Such narrow content based filtering is much easier to get right…"; column 7, lines 12-15: "…Any secure one-way hashing algorithm may be used. Algorithms include (but are not limited to) MD5, SHA, and RIPE-MD…")
- *the sender messaging server generates the sequence of codes and includes them in issued tickets.*(see at column 7, lines 1-5: "…A Serial Number Field 40. Serial Number Field 40 holds the serial number of the electronic stamp. This number is issued by the sending system. A serial number must never be reissued. The simplest serial number generator is a counter that is incremented for each electronic stamp generated…"; column 8, lines 46-54: "…In step (a) Mail Transport Agent 12A delivers electronic mail to Sender Side Input 30. Delivery of electronic mail awakens the sender side apparatus and starts sender side processing.

Sender Side Input 30 hands the electronic mail to Control Module 31. In step (b) Control Module 31 generates a serial number one greater than the last serial number generated. It places the serial number in Serial Number Field 40 of the electronic stamp…")

12. With respect to Claim 5,

Sundsted discloses all of the above limitations, Sundsted further discloses,

- *wherein the tickets are added to messages in reverse order of generation of their codes.*(see at least column 10, lines 38-46: "…The invention in its preferred embodiment uses symmetric key cryptography to protect the electronic stamp while the electronic mail is in transit. In environments where access to the network or transport medium is limited to trusted parties, this is sufficient. However, in an environment where the trustworthiness of the parties having access is unknown, public key cryptography would be a more appropriate solution.…")

13. With respect to Claim 6,

Sundsted discloses all of the above limitations, Sunsted further discloses,

- *wherein a mail server is provided with an end code of the sequence of codes and determines whether a ticket of the message includes a code from which the end code can be derived.* (see at least column 7, lines 1-5: "…A Serial Number Field 40. Serial Number Field 40 holds the serial number of the electronic stamp. This number is issued by the sending system. A serial number must never be reissued. The simplest serial number generator is a counter that is incremented for each electronic stamp generated…" ; column 7, lines 46-57: "…In step (a) Mail Transport Agent 12B delivers electronic mail to Receiver Side Input 20. Delivery of electronic mail awakens the receiver side apparatus and starts receiver side processing. Receiver Side Input 20 hands the electronic mail to Disassembly Module 21…In step (b) Disassembly Module 21 removes the electronic stamp from the electronic mail. Disassembly Module 21 hands both the electronic stamp and the electronic mail to Decryption Module 22.

In step (c) Decryption Module 22 decrypts the electronic stamp. Decryption Module 22 hands both the electronic stamp and the electronic mail to Analysis Module 23. …")

14. With respect to Claims 7, and 20,

Sundsted discloses all of the above limitations, Sundsted further discloses,

- *the recipient's mail system can validate the ticket with the ticketing entity before presenting the message to the recipient* (see at least claim 3, column 11, liens 59-60: "... encrypting, on said sender's side, said electronic stamping means before sending it to said intended receiver...")

15. With respect to Claims 8, 17, and 21,

Sundsted discloses all of the above limitations, Sundsted further discloses,

- *the recipient's mail system can automatically discard messages with ticket values below a threshold value set by the recipient.*(see at least column 10, lines 59-60: "…The invention in its preferred embodiment simply discards rejected electronic mail…")

16. With respect to Claims 9, 10, 18, and 23,

Sundsted discloses all of the above limitations, Sundsted further discloses,

- *when the recipient redeems the ticket, an account of the sender is debited.* (see at least claim 2, column 11, lines 52-57: "…transferring, on said receiver's side, funds representing said value from said sender to said receiver upon acceptance of said electronic mail; whereby, said receiver is compensated for accepting said sender's electronic mail…")

17. With respect to Claim 16,

Sundsted discloses all of the above limitations, Sundsted further discloses,

- *wherein a sender messaging client generates the sequence of codes and provides a terminal code of the sequence to the sender messaging server.* (see at least claim 10, column 12, lines 53=54: "... an identification number of the sending system…")

18. With respect to Claim 19,

    Sundsted discloses all of the above limitations, Sundsted further discloses,

    - *the recipient messaging system presents messages to the recipient in an order based on the ticket values of the messages.*(see at least column column 10, line 67 thru column 11, lines 1-7: "…The system could also prioritize and/or expedite acceptable electronic mail. The invention could be extended to assign a priority to a piece of electronic mail based on the value of the associated electronic stamp. User agent software could then present the electronic mail to the user sorted according to that priority or otherwise expedite the delivery of the electronic mail…")

19. With respect to Claim 24,

    Sundsted discloses all of the above limitations, Sundsted further discloses,

    - *wherein a sender's account and a recipient's account are maintained by the same entity.*(see at least column 9, lines 38-44: "…This embodiment requires the services of a third party called a bank. The bank distributes electronic tokens. Electronic tokens are digital information and can be manipulated electronically. Every electronic token is unique. The electronic tokens represent money being held in accounts with the bank. Both the sender and the receiver have accounts with the bank…")

20. With respect to Claim 25,

    Sundsted discloses all of the above limitations, Sundsted further discloses,

    - *a sender's account and a recipient's account are maintained by different entities.*(see at least column 9, lines 56-60: "…It deposits the electronic token in the receiver's bank account. This

action increases the receiver's account balance. The bank takes care of actually transferring the money between the two accounts…")

21. With respect to Claim 26,

Sundsted discloses all of the above limitations, Sundsted further discloses,

- *wherein the entity that maintains the sender's account transfers the value to the entity that maintains the recipient's account.* (see at least column 9, lines 56-60: "…then decrypts and decodes the electronic token. It deposits the electronic token in the receiver's bank account. This action increases the receiver's account balance…")

22. With respect to Claim 27,

Sundsted discloses all of the above limitations, Sundsted further discloses,

- *validating that the ticket can be redeemed before presenting the ticket to the recipient.* (see at least column 5, lines 40-45: "…A key component of this invention is the electronic stamp. Like a postage stamp, an electronic stamp must be attached to a piece of electronic mail before the receiver side will accept it. If the electronic stamp is not present, the receiver side will automatically reject the piece of electronic mail before the receiver ever sees it…")

Response to Arguments

23. Applicant's arguments received on March 9, 2009 have been fully considered but they are moot in view of the new ground(s) of rejection.

Conclusion

24. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929.** The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **John Weiss** can be reached at **571.272.6812.**

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/KIMBERLY EVANS/Examiner, Art Unit 3629

/Jonathan Ouellette/

Primary Examiner, Art Unit 3629